



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/820,377

03/27/2001

Daniel F. Williams

PSTM0041/MRK

5661

29524

7590

05/26/2006

KHORSANDI PATENT LAW GROUP, A.L.C.
140 S. LAKE., SUITE 312
PASADENA, CA 91101-4710

EXAMINER

WEBB, JAMISUE A

ART UNIT

PAPER NUMBER

3629

DATE MAILED: 05/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/820,377

Applicant(s)

WILLIAMS ET AL.

Examiner

Jamisia A. Webb

Art Unit

3629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-6, 8, 9 and 15-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 10-14 and 23-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20020610
20020610
20020104
20010527
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed 1/18/05 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The claims have added the following limitations which are not supported by the original specification “the first user is designated in a memory accessible by the computer system as restricted from finalizing shipping labels” the specification talks about users being able to finalize shipping labels, but not specifically disclose the system designating users as being “restricted from finalizing the shipping labels” does not appear in the specification, therefore the applicant not having support for this phrase in the original disclosure. Applicant is invited to point to a specific page in the specification where it discloses that printing a shipping label is considered to be finalizing a label.

2. Applicant has also added the newly added limitation of “in response to an input by a first user of the plurality of users, display interactive graphic user interface shipping selection options to the first user according to the first set of shipping privileges”. This limitation is considered to be new matter. The drawings of the claims show a general interface where users can select the carrier and generate a shipping label, but never shows an interactive user interface which is specific towards the first set of users, with specific privileges. The specification discloses many different embodiments and features of the invention, as far as the examiner could tell, this feature

Art Unit: 3629

was not present in the specification, however the examiner is invited to point out in the specification where this new limitation has support.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 7, 10, 11, 13 and 14 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See above "objection to amendment" for reasoning.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 7, 10-14, and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gendreau (US 2001/0034608) in view of Stefik et al (US 2003/0115144).

Art Unit: 3629

3. With respect to Claim 7: Gendreau discloses the use of a management computer system used for carriers, where the system:

- a. Receives a request to ship a parcel where the request contains partial shipment information comprising names and addresses (Paragraph 0032);
- b. Generating and printing a traveler label comprising a barcode (Invoice 22, Paragraph 0032).
- c. Save in memory, a relationship between the machine-readable code and the set of partial shipment information (Paragraphs 0032, 0033 and 0042), Gendreau discloses saving the information with bar-coded information, therefore due to the fact that the barcoded information is saved along with the data, the examiner considers that to be a relationship between the code and the information. Furthermore Gendreau discloses the information can be analyzed and consolidated for shipping, therefore the information is saved for that, and the shipping labels can be printed at an end of the day processing, therefore the information is retrieved from memory to print the shipping label.
- d. Generate a shipping label comprising the partial shipment information (27).

4. Gendreau however, fails to disclose the computer system being capable of assigning printing rights to a user, whether the user is designated as being able to print a shipping label, and finalize a shipping label. Stefik, discloses a first set of instructions input by an administrator of an enterprise, designate in a memory accessible by the computer system a setting for a user to be restricted from printing but capable of submitting requests (See Figure 4a and paragraphs 0016, 0040, 0065-0067). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Gendreau, to allow for the restricting

Art Unit: 3629

of printing and finalizing documents, in order to control the use of a digital work (See Stefik, abstract).

5. With respect to Claim 23: See Gendreau Paragraphs 0032 and 0040 and 0042.
6. With respect to Claims 24 and 25: See Gendreau Figure 1 with corresponding detailed descriptions.
7. With respect to Claim 26: See Gendreau Paragraphs 0034 and 0050.

5. Claims 10-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gendreau (US 2001/0034608) in view of Stefik et al (US 2003/0115144), and further in view of Kara (6,233,568).

8. With respect to Claim 10: Gendreau discloses the use of a management computer system used for printing invoices and shipping labels but fails to disclose designating users as having printing privileges and shipping privileges. Stefik discloses a computer system which is programmed to:

- a. According to a first set of instructions input by an administrator of an enterprise, designate in a memory accessible by the computer system a setting for a user to be restricted from printing but capable of submitting requests (See Figure 4a and paragraphs 0016, 0040, 0065-0067). The examiner considers the system of Stefik to be fully capable of being used with shipping labels and shipping requests due to the fact that this is considered to be intended use. It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify the computer system of

Art Unit: 3629

Gendreau, to include the privileges for restriction of privileges, as taught by Stefik, in order to control the use of digital works and images. (See Stefik, abstract)

b. Gendreau and Stefik fail to disclose the use of an interactive graphic user interface, in response to an input by a first user. Kara discloses the use of a system and method for selecting a carrier, based on shipping rates, where a user logs into an account (therefore has shipping privileges), and an interactive user interface is displayed for the selection of a carrier (See Figures 4B and 8A, with corresponding detailed description). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Gendreau and Stefik, to include an interactive user interface, in order to provide a user with information to make an informed choice as to a most preferable method of shipment. (See Kara, abstract, and Column 6)

9. With respect to Claims 11 and 13: See Gendreau Paragraphs 0032,0033, 0042 and 0050.

10. With respect to Claim 12: See Gendreau Paragraph 0034.

11. With respect to Claim 14: See Gendreau Paragraphs 0032-0034.

Response to Arguments

6. With respect to Applicant's arguments that the specification does have support for "restricted from finalizing": First, the examiner has added a new objection for new matter in the case. However, the arguments to the previous new matter objection are not persuasive, and therefore rejection stands. The applicant has argued that printing a shipping label is one form of finalizing a shipping label, however the specification does not state that printing is a form of finalizing. One can always print a label before it is finalized, as a rough draft. Therefore just

Art Unit: 3629

because something is printing does not mean or imply that it is final. The specification gives weight to restricting a user from printing a label, but never states that the user is restricted from finalizing. The specification also allows a user to finalize a shipping label, but never states that they are restricted from performing the task. The objection stands above for the phrase “restricted from finalizing”. The applicant is invited to point to the specification where it states that printing a shipping label is a form of finalizing a shipping label. The applicant clearly has support for restricted from printing, however this phrase is not being objected to, the objection is for restricted from finalizing. The cited specification again gives weight to user privileges, such as printing, but the cited specification does not show the term “restricted from printing”.

Arguments are deemed non-persuasive, rejections stand as stated above.

7. With respect to Applicant’s argument that Gendreau and Stefik whether alone or in combination, disclose the claimed invention. It should be noted that the applicant is arguing based on the newly added claim limitations, which are addressed above in the application. The applicant has stated that Gendreau does not save a relationship between the machine-readable code and information related to a shipping request. Although as pointed out above, Gendreau discloses the computer inputs the information into the computer, then further processes the information and compares the information to matching bar-coded information, therefore the examiner considers this to be saving into memory. Furthermore, it should be noted the steps are not recited that they must be in order, therefore Gendreau discloses all the recited steps, therefore teaches the claimed limitations, and rejections stand as stated above.

8. With respect to Applicant’s arguments that Gendreau discloses the information saved in not a “relationship between a machine-readable code and shipment information” but rather the

Art Unit: 3629

actual information. Gendreau discloses the information is associated with the barcode, therefore it inherently has a relationship. The applicant has not disclosed the computer saves only the relationship and not the actual information as well. Therefore the argument is considered not persuasive and rejection stands as stated above.

9. With respect to Applicant's argument that Stefik and Gendreau do not disclose the user interactive display, this argument is moot in view of the new rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

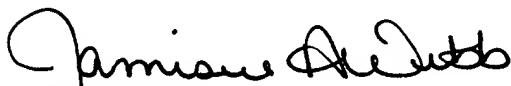
Art Unit: 3629

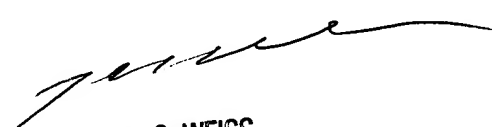
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (571) 272-6811.

The examiner can normally be reached on M-F (7:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jamisue Webb


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3800